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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,672

11/18/2003

Osamu Yamashita

WN-2622

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21254

7590

12/18/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

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SUITE 200

VIENNA, VA 22182-3817

EXAMINER

SHEDRICK, CHARLES TERRELL

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,672

Applicant(s)

YAMASHITA ET AL.

Examiner

CHARLES SHEDRICK

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/21/08 have been fully considered but they are not persuasive.

2. Regarding claims 21-24, Applicant argues:

Claims 21-24 stand rejected as obvious over Ramesh, further in view of Palenius, and further yet in view of Vazvan, further even if combined, the combination would not result in the claimed invention...therefore, even if secondary reference Palenius and tertiary reference Vazvan were to be combined with primary reference Ramesh, the combination would not provide the result described in the independent claims.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Vanzaan teaches a desire for multimode and dual-mode terminals used by the multimode system to provide the users of these equipment access to two or more satellite-based or terrestrial mobile communication systems, a selective multiple access system, which includes a price-quality selection system and provides the mobile terminal with information needed to select the optimal network. Discussing the question of obviousness of a patent that claims a

combination of known elements, the Court in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) explains: When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.]*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57 (1969)] are illustrative--a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *KSR*, 127 S. Ct. at 1740. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that "there was an apparent reason to combine the known elements in the fashion claimed." *Id.*, 127 S. Ct., at 1740-41. Such a showing requires "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

4. Regarding New Claim 29

Based on the claim language when taken into context with the Applicant's specification, the Method of claim 29 is essentially the same subject matter as the method of independent claim 21 and device of independent claim 23 and is therefore rejected based on the same reasoning of claims 21 and 23 (e.g., based on a lack of implicit language in the specification as to "sequentially taking measurements", the closest interpretation/intention gleaned from the specification appears to be a series of measurements.)

5. Regarding New Claims 25, 27, 30 and 32:

Applicant's arguments with respect to claims 25, 27, 30 and 32 have been considered but are moot in view of the new ground(s) of rejection.

6. Regarding New Claims 26, 28 and 31, Applicant argues:

New claims 25-28 and 31 are based on the description at lines 16-21 of page 7 of the specification.

However, The Examiner is unable to find any such support for claims 26, 28 and 31. In particular nothing in the Applicants original specification (i.e., the entire specification) that outlines the meaning or uses "unusually strong" or "interrupted".

The description at lines 16-21 of page 7 of the specification reads:

"previously mentioned averaging stages have been completed. However, if an initially strong signal is located, there is no particular disadvantage in attempting to read the signal even the signal strength may not yet have been averaged. Again, this can lead to a vastly more efficient use of the acquisition period so as to lead to time saving and reduction in dead time experienced by the user."

The Examiner respectfully submits that there is nothing the claim language that would support such a claimed assertion. The specification points out an initially strong signal which is precisely

what the mobile device is looking for in prior art systems (i.e., the five strongest).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 26, 28 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **See further remarks in response to arguments.**

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 26, 28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. The term "unusually strong" in claims 26, 28 and 31 is a relative term which renders the claim indefinite. The term "unusually strong" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. **See further remarks in response to arguments.**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ramesh et al. WO 02/37889 A1**, “Ramesh”, hereinafter in view of **Palenius et al. US Patent Pub. No.2004/0058650 A1**, “Palenius”, hereinafter and further in view of **Vazvan et al., US Patent No: 6,400,946**, hereinafter, “Vazvan”

Consider **claims 21, 23 and 29**, Ramesh teaches a method and means of determining a most suitable cell **12 (Figure 1)**(i.e., Channel allocation) during network acquisition for a cellular communication device **100 (Figure 1)** based on a characteristic of signals (i.e., power measurements) received from a plurality of cells **12 (Figure 1)**(**pg.5 lines 1-5**), the signals from each cell being provided over a band of frequencies, and said method comprising: taking a series of measurements of said characteristic for each frequency of a first band(**pg. 8 lines 20-21**), so as to obtain an average measurement value of said characteristic for each frequency of said first frequency band(**pg. 3 lines 1-25**),wherein the series of measurements on said first frequency band are equally spaced in time, with equal time intervals there between(**pg. 10 lines 3-23**).

However, Ramesh does not specifically teach during the time intervals between measurements for said fist frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band.

In the same field of endeavor, Palenius teaches during the time intervals between measurements for said first frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band (i.e., see figure 2)(**paragraph 0014 and paragraph 0033**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ramesh to include during the time intervals between measurements for said fist frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band as taught by Palenius for the purpose of efficient cell search.

However, Ramesh as modified by Palenius does not specifically teach first and second frequency bands that operate in different operating modes.

In analogous art, Vazvan teaches first and second frequency bands that operate in different operating modes (e.g., see **multimode and dual mode operation in abstract and at least col. 2 lines 17-20, col. 3 lines 40-45**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ramesh as modified by Palenius to include multimode operation for the purpose of integration and flexibility and taught by Vazvan in col. 3.

Consider **claims 22, 24 and 32 and as applied to claims 21, 23 and 29** respectively, Ramesh as modified by Palenius teaches the claimed invention except wherein one operation mode comprises GSM, and the other operating mode comprises UMTS.

However, in analogous art, Vazvan teaches except wherein one operation mode comprises GSM, and the other operating mode comprises UMTS (e.g., see **at least col. 1 lines 65 and col. 3 lines 24-25**)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ramesh as modified by Palenius to include wherein one operation mode comprises GSM, and the other operating mode comprises UMTS for the purpose of integration and flexibility and taught by Vazvan in col. 3.

Consider **claims 25 and 27 and as applied to claims 21 and 23** respectively, Ramesh **as modified by Palenius and further modified by Vazvan** teaches the claimed invention wherein said series of measurements is repeated a predetermined number of times to calculate said average measurement for each of said frequency(e.g., see **at least page 3 lines 3-17**)

Consider **claims 26, 28 and 31 and as applied to claims 25, 27 and 29** respectively, see response to arguments and 112 rejections).

Consider **claim 30 and as applied to claims 29, Ramesh as modified by Palenius and further modified by Vazvan** teaches wherein said characteristic comprises signal strength (i.e., power)(e.g., see at least page 3 lines 15-20).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles Shedrick/
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617